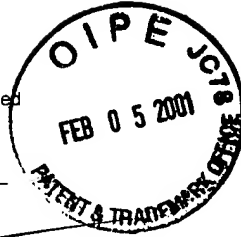


I hereby certify that this correspondence is being filed by depositing it with the United States Postal Service as first class mail in an envelope with sufficient postage and addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 on the date indicated below.

Date: January 29, 2001

Signed: 
Peter K. Trzyna (Reg. No. 32,601)



PATENT

Paper No. 29

File: Kor1-CIP

AF-111x
3770
3618
#29
Appeal Brief
2-9-01
CEIVED

FEB 08 2001
TO 3600 MAIL ROOM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors : Charles Kormanik, Jr.
Serial No. : 08/802,472
Filed : February 18, 1997
For : THEMATIC PACKAGING SYSTEM
Group Art Unit : 3208
Examiner : Luby, M.

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

TRANSMITTAL LETTER

S I R :

Please enter the following enclosed documents in the above-identified patent application.

1. Two copies of Brief on Appeal On Behalf of Appellant, filed December 19, 2000; and
2. Response to Communication Re: Defective Notice of Appeal or Defective Brief.

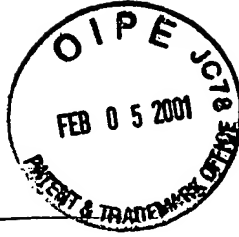
The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

I hereby certify that this correspondence is being filed by depositing it with the United States Postal Service as first class mail in an envelope with sufficient postage and addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 on the date indicated below.

Date: January 29, 2001

Signed: 

Peter K. Trzyna (Reg. No. 32,601)



PATENT

Paper No. 29

File: Kor1-CIP

RECEIVED

FEB 08 2001

TO 3600 MAIL ROOM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors	:	Charles Kormanik, Jr.
Serial No.	:	08/802,472
Filed	:	February 18, 1997
For	:	THEMATIC PACKAGING SYSTEM
Group Art Unit	:	3208
Examiner	:	Luby, M.

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

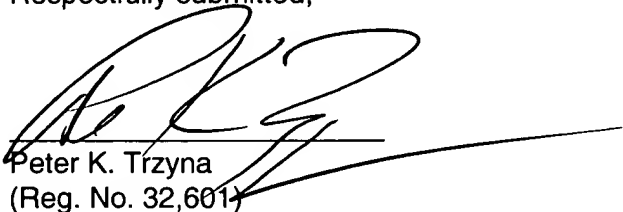
**RESPONSE TO COMMUNICATION RE: DEFECTIVE
NOTICE OF APPEAL OR DEFECTIVE BRIEF**

S I R :

In response to the Communication Re: Defective Notice of Appeal or Defective Brief (Paper No. 28) issued on January 23, 2001, Appellant is filing herewith two additional copies of the Brief on Appeal on Behalf of Appellant, filed December 19, 2000.

Respectfully submitted,

Date: January 29, 2001


Peter K. Trzyna
(Reg. No. 32,601)

P.O. Box 7131
Chicago, IL 60680-7131
(312) 240-0824

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,

Date: January 29, 2001



Peter K. Trzyna
(Reg. No. 32,601)

P.O. Box 7131
Chicago, IL 60680-7131

(312) 240-0824

I hereby certify that this correspondence is being filed by United States Postal Service as first class mail in an envelope with sufficient postage and addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 on the date indicated below.

Date: December 10, 2000


(Signature of person mailing paper or fee)

PATENT

Paper No.

File: Kor1-CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors

Charles Kormanik, Jr.

Serial No.

08/802,472

Filed

February 18, 1997

For

: THEMATIC PACKAGING SYSTEM

Group Art Unit

: 3208

Examiner

: Luby, M.



RECEIVED

FEB 08 2001

TO 3600 MAIL ROOM

**BRIEF ON APPEAL
ON BEHALF OF APPELLANT**

TABLE OF CONTENTS

Title Page	1
Certificate Under 37 C.F.R. §1.8(a)	1
Table of Contents	2
Table of Cited Decisions	3
Appeal Brief	5
Real Party in Interest	5
Related Appeals and Interferences	5
Status of All Claims	5
Status of All Amendments Filed Subsequent to Final Rejection	6
Concise Summary of the Invention	6
Concise Statement of All Issues Presented for Review	11
Grouping of Claims for Each Ground of Rejection Which Appellant Contests	12
Argument	13
Conclusion	34
Appendix	36

RECEIVED

FEB 08 2001

TO 3600 MAIL ROOM




TABLE OF CITED DECISIONS

<u>E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.</u> , 7 USPQ2d 1129 (Fed. Cir. 1988)	15
<u>Mendenhall v. Astec Industries, Inc.</u> , 13 USPQ2d 1913, 1939 (TN 1988), <u>aff'd</u> , 13 USPQ2d 1956 (Fed. Cir. 1989)	16
<u>Diversitech Corp. v. Century Steps, Inc.</u> , 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988)	16
<u>Pac-Tec, Inc. v. Amerace Corp.</u> , 903 F.2d 796, 14 USPQ2d 1871 (Fed. Cir. 1990)	16
<u>In re Wright</u> , 848 F.2d 688, 16 USPQ2d 1959 (Fed. Cir. 1988)	17
<u>Hybritech Inc. v. Monoclonal Antibodies, Inc.</u> , 802, F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986)	17
<u>Southwest Industrial Products, Inc. v. Ezee Stone Cutter Manufacturing Company et. al.</u> , 116 USPQ 362 (W.D. Ark. 1957)	18
<u>In re Horn, Horn, Horn and Horn</u> , 203 USPQ 969 (CCPA 1979)	18
<u>Southwest Industrial Products, Inc. v. Ezee Stone Cutter Manufacturing Company et. al.</u> , 116 USPQ 362 (W.D. Ark. 1957)	18
<u>Interconnect Planning Corp., v. Feil</u> , 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985)	18
<u>Northern Telecom, Inc. v. Datapoint Corp.</u> , 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990)	18
<u>The Anderson Company et al. v. Trico Products Corporation</u> (W.D. N.Y. 1958) 118 USPQ 49 1958	19
<u>In re Benno</u> , 226 USPQ 683 (Fed. Cir. 1985)	19
<u>King Instrument Corp. v. Otari Corp.</u> , 226 USPQ 402 (Fed. Cir. 1985)	19
<u>Panduit Corp. v. Dennison Manufacturing Co.</u> , 1 USPQ2d 1593 (Fed. Cir. 1987)	20

<u>Gillette Co., v. S.C. Johnson & Sons, Inc.</u> , 919 F.2d 720, 16 USPQ2d 1923 (Fed. Cir. 1990)	20
<u>Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.</u> , 230 USPQ 416 (Fed. Cir. 1986), USPQ 657 (Fed. Cir. 1985)	20
<u>In re Bisley</u> , 94 USPQ 80, 86, 87 (CCPA 1952)	20
<u>Structural Rubber Prod., Co. v. Park Rubber Co.</u> , 749 F.2d 707, 223 USPO 1264 (Fed. Cir. 1984)	21
<u>In re Bond</u> , 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)	21

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors : Charles Kormanik, Jr.
Serial No. 08/802,472
Filed FEB 05 2001 February 18, 1997
For THEMATIC PACKAGING SYSTEM
Group Art Unit : 3208
Examiner : Luby, M.



Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

**BRIEF ON APPEAL
ON BEHALF OF APPELLANT**

S I R :

This is an appeal from the Final Action of the Examiner dated July 11, 2000, rejecting claims 5, 8-15⁵ and 17-31 all claims pending in this application.

Please charge the fee under 37 C.F.R. § 1.17, the fee for Extension of Time for filing of this Brief, and any other fee necessary for filing this Brief on Appeal, or for further prosecution, to Deposit Account No. 50-0235.

II. Real Party In Interest

Appellant, Charles Kormanik, is the real party in interest in this matter.

III. Related Appeals and Interferences

There are no related appeals or interferences.

IV. Status of All Claims

All claims have been rejected.

V. Status of All Amendments Filed Subsequent to Final Rejection

One Amendment was filed subsequent to the Final Rejection, pursuant to which the Examiner has withdrawn all §112 rejections. A second Amendment filed subsequent to the Final Rejection addressed a previously unnoticed §112 issue.

VI. Concise Summary of the Invention

The invention is directed to a method for making thematic packaging including an item related to, and useful in, an activity visually associated with the theme of the package.

As an example, the thematically configured package could be in the shape of a golf ball to visually indicate or suggest "playing golf," and the article therein could be a rain poncho for use in playing a game of golf in the rain.

VII. Reading of Claims on the Specification

The claims on Appeal read on the specification as follows:

5. A method for making a combination of a thematic package and an article contained within the package, the method including the steps of:

constructing the package as a replica of a recognizable icon, the package having a shape that is different than a shape of the article contained therein,

the shape of the package visually conveying information about an activity associated with the icon in which the article is used, and,

the package having a hollow interior; and

locating the article within the hollow interior of the package to form a combination of the article and the thematically-shaped package.

8. The method of claim 5, wherein the step of constructing includes: constructing a replica of a golf ball.

9. The method of claim 5, wherein the step of constructing includes: constructing a replica of a baseball.

10. The method of claim 5, wherein the step of constructing includes: constructing a replica of a life preserver.

11. The method of claim 5, wherein the step of constructing includes: constructing a replica of a football.

12. The method of claim 5, wherein the step of constructing includes: constructing a replica of a tennis ball.

13. The method of claim 5, wherein the step of constructing includes: constructing a replica of a soccer ball.

14. The method of claim 5, wherein the step of constructing includes:

form a combination...packaging. Pg14, Ln1-5

shape...or suggestive. Pg13, Ln3-4

symbol...suggestive of an activity Pg13, Ln8-9

...having a hollow... Pg4, Ln18

locating...within the packaging. Pg4, Ln22

packaging ... golf ball. Pg12, Ln13

packaging ... baseballs Pg13, Ln29

life preserver Pg13, Ln22

packaging ... footballs Pg13, Ln29

packaging ... tennis balls =Pg13, Ln29

baseballs..., etc. Pg13, Ln29-30

constructing a replica of a rugby ball.

15. The method of claim 5, wherein the step of constructing includes: constructing a card symbolizing charge and bank cards.

three dimensional ... card...packaging Pg14, Ln12-15

17. The method of claim 5, further including the step of locating a logo on the replica.

Visa...American Express Pg14, Ln13-14

18. The method of claim 5, further including the step of: adding an outer layer of packaging also shaped to visually convey information about the associated activity.

Three...packaging 52...in a...box 54. Pg12, Ln26-28

19. The method of claim 18, wherein the outer layer includes a sleeve for golf balls.

"sleeve" of golf balls. Pg12, Ln29

20. The method of claim 5, wherein the step of constructing further includes the step of:

constructing the replica to have additional utility and having a shape visually conveying information about an activity associated with the replica.

packaging...independent utility Pg15, Ln10-12; golf related purpose p15, l5

21. The method of claim 19, wherein the step of constructing the replica to have additional utility includes the step of:

constructing a toy.

toy/or...Pg15, Ln13

22. The method of claim 20, wherein the step of constructing the replica to have additional utility further includes the step of:

constructing the replica to receive subsequent writing from a pen or magic marker thereon.

receive writing...Pg12, Ln23-24

23. The method of claim 5, further including a means for attaching the replica to another article.

ring, tab, fixture...attaching the packaging to another article. Pg15, Ln14-17

24. A method for making packaging, the method including the steps of:

providing an object in a package,

the package being shaped like a particular ball to visually convey information about a particular activity associated with said ball,

the object being a member of the group of rain gear consisting of a wiping cloth, a rain coat, a rain vest, a golf bag cover, a ditty bag, a poncho, a hat, and a seat cover

the member being useful during the activity wherein the package is openable to remove the object for use of the object while engaged in the associated activity.

25. A method for making thematically-shaped packaging for a thematically associated article contained therein, the method including the step of:

constructing a package having a shape that is a recognizable icon visually conveying information about an activity associated with the icon,

the package having a hollow interior to form the packaging for the article;

locating the article within the hollow interior of the package,

the article having a use in the associated activity to form a combination of the article and the thematically-shaped packaging; and wherein the step of constructing further includes the step of:

constructing the package as a replica of a golf ball to visually convey information of association of the activity of a game of golf; and wherein the step of locating the article within the packaging further includes the step

item inside the package Pg15, Ln23

packaging is shaped as a golf ball. p15, l22

rain...seat cover Pg12, Ln31-32

protective sleeve 2 can be located in thematic packaging. Pg12, Ln10-11; two hemispheric halves...joinable...encase protective sleeve 2. p12, l17-21

shape...or suggestive. Pg13, Ln3-4

symbol...suggestive of an activity Pg13, Ln8-9

...having a hollow...Pg4, Ln18

locating...within the packaging. Pg4, Ln22

...golf related purpose...Pg15, Ln5

thematic packaging resembles a golf ball. Pg12, Ln13

of:

locating rain gear, as the article, within the hollow interior of the replica such that the rain gear is visually associated for use in the activity of playing the game of golf in the rain.

26. --A method of making thematically-shaped packaging for an article contained therein, the method including the steps of:

constructing the package as a replica of a symbol having a shape that visually conveys information about an activity associated with the symbol,

the package having a hollow interior to form the packaging for the article;

locating the article within the hollow interior of the packaging,

the article having a use in the associated activity

and forming activity and forming a combination of the article and the thematically-shaped packaging;

and wherein the step of constructing further includes the step of:

constructing the package as a replica of a baseball to visually convey information about the associated activity of a baseball game;

and wherein the step of locating the article within the package further includes the step of:

locating rain gear, as the article, within the packaging such that the rain gear is visually associated with the associated activity of watching the baseball game in the rain.

golf related...suggestive of their use. Pg13, Ln1-3

form a combination...packaging. Pg14, Ln1-5

shape...or suggestive.... Pg13, Ln3-4

...having a hollow...Pg4, Ln18

locating...within the packaging. Pg4, Ln22

golf related...suggestive of their use. Pg13, Ln1-3

form a combination...packaging. Pg14, Ln1-5

baseballs...sporting events Pg14, Ln29-30

locating...within the packaging. Pg4, Ln22

symbol...suggestive of an activity Pg13, Ln8-9

27. The method of any one claims 5 and 8-23, further including the step of:

packaging the package within an other package, the other package suggestive of the member of the group.

three...packaging 52...in a...box 54. Pg12, Ln26-28

28. The method of any one of claims 5 and 8-23, wherein the step of locating the article within the hollow

locating...within the packaging. Pg4, Ln22

includes engaging lips on respective portions of the package to encase the article, the portions forming halves of the hollow when joined during the locating step.

joinable by interior lip 58 that engages exterior lip 60 when the halves are pushed together...Pg12, Ln19-20

29. The method of any one claims 5 and 8-23, wherein the step of constructing includes constructing out of plastic.

constructing a plastic replica of a golf ball...Pg4, Ln19-20

30. The method of claim 29, wherein the step of locating is carried out with the article being an article made of plastic.

protective sleeve...made...of plastic. Pg9, Ln4-5

31. The method of claim 26, wherein the step of locating the article within the hollow includes engaging lips on respective portions of the ball to encase the article.

joinable by interior lip 58 that engages exterior lip 60 when the halves are pushed together...Pg12, Ln19-20

VIII. Concise Statement of All Issues Presented for Review

As stated hereinabove, all §112 rejections have been overcome.

A. Pursuant to 35 §U.S.C. 102(b), is claim 5 anticipated by Agapiou U.S. Patent No. 4,815,607?

B. Pursuant to 35 §U.S.C. 103(a), are claims 8-15 and 17-31 obvious in view of Agapiou?

IX. Grouping of Claims for Each Ground of Rejection Which Appellant Contests

Claim 5 should stand alone against the 35 U.S.C. §102(b) rejection.

Claims 8-15, 17-28, and 31 should stand alone against the 35 USC 103(a) rejection.

--Claims 29 and 30 should stand with claim 5.

X. Argument

A. Summary Regarding The §102 Rejection

Generally, in rejecting claim 5 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,815,607 (Agapiou), the Examiner contends:

Agapiou discloses... the tire shape visually conveying information about a safety activity for learning about safety procedures around motor vehicles

(Final Rejection Page 3, Paragraph 4, italicized added)

1. The Examiner's Personal Association Is Not A Reference Teaching

First, the above-quoted rejection depends on the Examiner's personal interpretation as to what information the tire (exterior of the kit) of Agapiou is conveying as well as what activity the Agapiou tire is associated with. A contemporary personal interpretation does not make a §102 reference teaching.

The Agapiou reference does not teach a tire-shaped package conveying information about "a safety activity." For example, arguably another person might instead interpret the Agapiou flat tire in Fig. 1 as conveying something about changing a flat tire or the like, rather than as information about a safety activity. Agapiou does not teach a tire-shaped package visually conveying information about "a safety activity" except in the mind of the Examiner.

The Examiner's contemporary interpretation is different from what the evidence of record establishes. The §102 anticipation rejection depends on the Examiner's personal

association and interpretation in combination with the reference, and therefore the rejection is not based on sufficient §102 evidence.

2. The Examiner Applies Vague Contention To A Misconstrued Claim

Second, the Examiner has not indicated what information is conveyed and what safety activity is disclosed by the Agapiou tire to form the basis for the anticipation denial of a patent. Further, the vagueness of the Examiner's contention concerning what information and what safety activity is disclosed by the Agapiou tire is applied to a misconstrued claim. The Examiner states:

all shapes visually convey information about an activity associated with package

(Final Rejection Page 3, Paragraph 4)

However, the claim requires conveying information about an activity associated with the icon, not the *package*, and the contention is false as well: amorphous shapes and geometric solids, for example, convey no information whatsoever about either an activity or a package (sic). A L'eggs egg container conveys no clue how to use the nylons therein, etc.

The Examiner's vague interpretation of both the reference teaching and the requirement of the claim -- that some information is conveyed by the Agapiou tire and that there is some safety activity associated with the package -- is not the same as a §102 reference teaching, especially under the correct requirements of the claims.

3. The Examiner's Contention Does Not Fit Other Claim Requirements Applied to Agapiou

Third, even if one accepts the Examiner's subjective association of the Agapiou reference's tire as visually conveying some information about some safety activity, then the other claim requirements still cannot be plausibly applied to the reference.

As it is understood, the Examiner's contention is that the claim corresponds to the Agapiou teaching as follows:

Claim 5

an article
in a thematic package
visually conveying information
about-an activity

associated with the icon
in which the article
is used.

Agapiou

[toy]
[tire-shaped exterior of a kit]
[a safety activity for learning
about safety procedures around
motor vehicles]
[a real tire]
[toy]
[does not exist]

However, in this interpretation of Agapiou, as applied to claim 5, the learning of safety is carried out with the toy in association with its tire-shaped container (i.e., a “kit”), not with the toy in association with a real tire, as would follow from the claim requirements. The Examiner’s contention, as it is understood, is inconsistent with the requirements of claim 5.

3. Agapiou Does Not Teach The Claimed: *visually conveying information about an activity associated with the icon*

More particularly, Agapiou's tire does not visually indicate “information about a safety activity for learning about safety procedures around motor vehicles” as contended by the Examiner. Agapiou teaches a tire-shaped container, which in the preferred embodiment, is flat along a portion of a periphery thereof, for enabling the container to stand erect, although in a secondary embodiment, the tire appears fully inflated, with a stand provided to hold same erect. See Agapiou at Col. 2, lines 40-44. In both embodiments, the “toy” of Agapiou, which may be placed within either tire-shaped container when not in use, may be in the form of a human or an animal, either form having tire treads over a flattened center portion thereof. See Agapiou at Col. 2, lines 50-54.

Because claim 5 requires the shape of the package visually conveying information,

it is important to distinguish between what the Agapiou tire conveys from what the combination of the kit comprising the tire and the toy convey. Compare Fig. 1 and Fig. 3 of Agapiou. The abstract of Agapiou indicates that the patent concerns a safety awareness kit including toy figures and that the kit is apparently for use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire. See also Agapiou at Col. 1, lines 50-55.

In viewing either embodiment, the Agapiou tire-shaped container, flat or inflated, with the life form of Agapiou having tire tread across the body and lying beside the tire, neither embodiment can indicate usefulness of the dead (run-over) life form in an activity. Both embodiments merely suggest what can happen when form and tire meet under known laws of physics. Thus, Agapiou can only be found to visually indicate cause and effect. There is no suggestion or motivation in Agapiou to make the form within the package useful in an activity associated with a tire.

An alleged visual impression of a "hazard" associated with an activity cannot be construed as teaching a method for creating a thematic package in combination with an article to be placed within the package, which article is useful in an activity visually indicated by the theme of the package.

Also, inasmuch as Agapiou expressly limits his teachings to presentation of a safety awareness kit, such property of the kit necessarily serves as a restriction to the teachings thereof. See E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 7 USPQ2d 1129 (Fed. Cir. 1988)

"To find anticipation of claims, the prior-art embodiments must possess the properties expressly recited in the claims. Property limitations can serve to distinguish claimed subject matter from other products.

Further, picking and choosing arbitrarily from different aspects of Agapiou is not supportive of anticipation.

See Mendenhall v. Astec Industries, Inc., 13 USPQ2d 1913, 1939 (D. Tenn. 1988),

aff'd, 13 USPQ2d 1956 (Fed. Cir. 1989):

"Since the hypothetical person of ordinary skill in the art defined by 35 USC 103 is presumed to know of all pertinent prior art, consideration must be given to prior art that would lead one away from the invention as well as that which is argued to lead toward it."

See also Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988):

"The district court correctly found that the preamble of the claim was necessary to give meaning to the claim and therefore constituted an essential limitation in determining whether the claim was anticipated."

See further Pac-Tec, Inc. v. Amerace Corp., 903 F.2d 796, 14 USPQ2d 1871 (Fed. Cir. 1990):

"In determining anticipation functional language, preambles, and language in "whereby," "thereby," and "adapted to" clauses cannot be disregarded."

Therefore, for those reasons cited above, the Examiner has not provided sufficient evidence of anticipation with Agapiou.

B. Obviousness

1. Summary

In the rejection of claims 8-15 and 17-31 under 35 USC 103(a) as being unpatentable over the same Agapiou patent, the Examiner states:

"Agapiou discloses the claimed method including the package and article as described above including constructing the replica to receive writing from a pen or magic marker (see 30 - Figure 1). Agapiou does not particularly recite that the package resembles a particular ball, that the article is one of a wiping cloth, a rain coat, a rain vest, a golf bag cover, a ditty bag, a poncho, a hat and a seat cover; that the package is constructed as either a replica of a golf ball, a baseball a life preserver, a football, a tennis ball, a soccer ball, a rugby ball or a charge/bank card and that the article is rain gear or any other item useful during the activity. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Agapiou reference by having the package resemble a particular ball, that the article is selected from the group including a wiping cloth, a rain coat, a rain vest, a golf bag cover, a ditty bag, a poncho, a hat and a seat cover; the package is constructed as either a replica of a golf ball, a baseball, a life preserver, a football, a tennis ball, a

soccer ball, a rugby ball or a charge/bank card and that the article is rain gear, since a person of ordinary skill in the art at the time of the invention would provide a package with an article inside to resemble objects useful to the target consumer(s) who would purchase these items. It is notoriously well known to a place rain gear or any other article, for that matter, inside a package. Further it is also well known to construct that package to resemble a familiar symbol to the target consumer(s)."

(Final Rejection Page 4, Paragraph 6.)

The Examiner has articulated his sentiment that the invention is unpatentable. But in the United States, patentability is based on statutory standards applied to evidence, in ways that courts have previously discussed. It is respectfully submitted that the Examiner has not provided sufficient evidence to withhold a patent on the instant claims based on the required statutory standards.

More particularly, the Agapiou reference is insufficient for several reasons. First, Agapiou does not and cannot be read to disclose the method steps which makes Appellant's claimed method obvious. Indeed, the Examiner has not even addressed the *method steps* in the Final Rejection, relying solely on a product-oriented reference.

See In re Wright, 848 F.2d 688, 16 USPQ2d 1959 (Fed. Cir. 1988):

"[I]t is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves."

Appellant does not provide claimed structure to serve as an educational safety awareness kit. See Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986):

"Focusing on the obviousness of substitutions and differences instead of on the invention as a whole... was a legally improper way to simplify the difficult determination of obviousness."

Rather, Appellant provides a method of creating a thematic package within which an object useful in an activity visually indicated by the thematic package is received.

In order for obviousness to exist, conception of the principle of Appellant's teaching

must exist, as stated in Southwest Industrial Products, Inc. v. Ezee Stone Cutter Manufacturing Company et. al., 116 USPQ 362 (DC WARK) 1957:

"Although ... simple improvement, improvement takes on additional significance when it is observed that prior inventors in the field had failed to conceive or use such a principle; claims are valid."

---There is no indication anywhere in Agapiou of *method steps* to combine an item useful in a particular activity with a thematic package for the item, which package provides a visual indication of the activity within which the item within the package may be used. The claimed *method steps* of producing such combination are not even hinted at, let alone disclosed.

See In re Horn, Horn, Horn and Horn, 203 USPQ 969 (CCPA 1979):

"For the teachings of a reference to be prior art under 35 U.S.C. §103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the pertinent problem to which the invention pertains; for no matter what a reference teaches, it could not have rendered obvious anything (at the time the invention was made) to a person having ordinary skill in the art to which the subject matter pertains unless that hypothetical person would have considered it."

Second, the principle to which Agapiou's explicit teaching is directed would be defeated if the substitutions and modifications proposed by the Examiner were carried out, e.g., replacing the tire with a golf ball, making the Examiner's allegation nothing more than the use of improper hindsight reasoning.

Again, see Southwest Industrial Products, Inc. v. Ezee Stone Cutter Manufacturing Company et. al., 116 USPQ 362 (W.D. Ark 1957) 1957: "Hindsight is not proper basis for determining patentability.";

and Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985):

"It is error to reconstruct the patentee's claim as a 'blueprint'."

Substitution of an article useful in a visually indicated activity associated with the packaging would entirely defeat the stated purpose of Agapiou.

Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990) (2)

"Whether the changes from the prior art are minor...the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's method and device."

Thirdly one of the elements necessary for consideration under the Examiner's allegations, is whether the reference cited would have even been taken into consideration by an inventor working on a particular matter. Such a determination typically deals with a study of the title of the cited reference. See The Anderson Company et al. v. Trico Products Corporation 118 USPQ 49 (W.D. N.Y. 1958):

"Also, it is noted that ... is limited on its face by its title; hence, claims must be construed with some strictness."

Agapiou's title defines his patent to teach a "Safety Awareness Kit Including Toy Figures." Based on the law of the above-cited decision, one is hard pressed to find any suggestion in Agapiou that the teachings thereof would be applicable, even for consideration, by the Appellant herein inasmuch as the instant application has nothing to do with a safety education kit. From the opposite perspective, Agapiou has nothing to do with a method of symbolically indicating an activity by his choice of packaging, within which activity the content of the package is useful.

See In re Benno, 226 USPQ 683 (Fed. Cir. 1985):

"In dismissing Dante as a reference, the court pointed out that Dante did not even hint at the problem the appellants sought to solve. Dante would not even have encountered the problem because it would not have appeared in what he was doing.";

and King Instrument Corp. v. Otari Corp., 226 USPQ 402 (Fed. Cir. 1985):

"A reference is not available under 35 U.S.C. §103 if it is not within the field of the inventor's endeavor and was not directly pertinent to the particular problem with which the inventor was involved."

In actuality, the teachings of Agapiou can be determined to lead away from the claimed *method steps* inasmuch as the content of Agapiou's patent visually indicates a result of

an activity, and has in no way and can in no way indicate usefulness of his "toys" within the activity visually indicated by the packaging (i.e., how is a run-over-appearing skunk useful to a driver?).

See Panduit Corp. v. Dennison Manufacturing Co., 1 USPQ2d 1593 (Fed. Cir. 1987):

"A prior patent must be considered in its entirety (i.e., as a whole), including portions that would lead away from the invention in issue."

The inventive height of usefulness of an item within a thematic package is never an issue in Agapiou. See Gillette Co. v. S.C. Johnson & Sons, Inc., 919 F.2d 720, 16 USPQ2d 1923 (Fed. Cir. 1990).

"An analysis of obviousness ... must include consideration of the results achieved"

Accordingly, again, anticipation and/or obviousness cannot be elicited from the teachings of Agapiou.

Perhaps if Agapiou had placed a lug wrench, car jack, etc. within his flat-tire-shaped container, that combination might have been considered closer to rendering Appellant's method obvious and/or anticipated. However such substitution would defeat the purpose of safety awareness education to which Agapiou restricts his disclosure.

Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 USPQ 416 (Fed. Cir. 1986) USPQ 657 (Fed. Cir. 1985):

"It is impermissible within the framework of 35 U.S.C. §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.";

and In re Bisley, 94 USPQ 80, 86, 87 (CCPA 1952):

"Patentability is gauged not only by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not necessarily negative invention or patentability."

Based on such lack of congruence between the teachings and utility of Agapiou and those of Appellant, neither anticipation nor obviousness can exist and the rejection cannot stand. Structural Rubber Prod. Co. v. Park Rubber Co., 749 F.2d 707, 223 USPO 1264 (Fed. Cir. 1984)

"Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. Anticipation is not shown even if ...the differences between the claims and the prior art references are "insubstantial" and the missing elements could be supplied by the knowledge of one skilled in the art.";

and In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990):

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference ... These elements must be arranged as in the claim under review."

Again, there is no teaching, suggestion, or motivation in Agapiou to combine a thematic package with an item to be packaged therein, which item is useful in an activity visually indicated by the theme of the package.

2. Agapiou Does Not Teach Or Suggest The Method Step Of Constructing A Replica Of A Golf Ball

With regard to claim 8, Agapiou does not teach or suggest the method step of constructing a replica of a golf ball, and indeed, has nothing to do with golf balls.

As stated above, the abstract of Agapiou indicates that the patent concerns a safety awareness kit including toy figures and that the kit is apparently for use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire. See also Agapiou at Col. 1, lines 50-55. There is no teaching or suggestion of the method step in claim 8.

Further, replacing the tire-shaped container with a golf ball and placing the same in proximity to the toy, as the Examiner apparently contends, would defeat the purpose of Agapiou. That is, exchanging the golf ball for the tire would likely render laughable Agapiou's

utility for "use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire."

3. Agapiou Does Not Teach Or Suggest The Method Step Of Constructing A Replica Of A Baseball

As to claim 9, Agapiou does not teach or suggest the method step of constructing a replica of a baseball, and indeed, has nothing to do with baseballs.

As indicated above, the abstract of Agapiou indicates that the patent concerns a safety awareness kit including toy figures and that the kit is apparently for use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire. See also Agapiou at Col. 1, lines 50-55. There is no teaching or suggestion of the method step in claim 9.

Further, replacing the Agapiou tire with a baseball in proximity to the squashed skunk, as the Examiner apparently contends, for "use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire" would also likely be laughable.

4. Agapiou Does Not Teach Or Suggest The Method Step Of Constructing A Replica Of A Life Preserver

As to claim 10, Agapiou does not teach or suggest the method step of constructing a replica of a life preserver, and indeed, has nothing to do with life preservers.

As indicated above, the abstract of Agapiou indicates that the patent concerns a safety awareness kit including toy figures and that the kit is apparently for use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire. See also Agapiou at Col. 1, lines 50-55. There is no teaching or suggestion of the method step in claim 10.

As above, replacing the Agapiou tire with a life preserver in proximity to the squashed skunk, as the Examiner apparently contends, for "use in educating young children by

providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire" would also likely be laughable.

5. Agapiou Does Not Teach Or Suggest The Method Step Of Constructing A Replica Of A Football

As to claim 11, Agapiou does not teach or suggest the method step of constructing a replica of a football, and indeed, has nothing to do with footballs.

As indicated above, the abstract of Agapiou indicates that the patent concerns a safety awareness kit including toy figures and that the kit is apparently for use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire. See also Agapiou at Col. 1, lines 50-55. There is no teaching or suggestion of the method step in claim 11.

As above, replacing the Agapiou tire with a football in proximity to a squashed skunk, as the Examiner apparently contends, for "use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire" would also likely reduce the Agapiou utility into humor.

6. Agapiou Does Not Teach Or Suggest The Method Step Of Constructing A Replica Of A Tennis Ball

As to claim 12, Agapiou does not teach or suggest the method step of constructing a replica of a tennis ball, and indeed, has nothing to do with tennis balls.

As indicated above, the abstract of Agapiou indicates that the patent concerns a safety awareness kit including toy figures and that the kit is apparently for use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire. See also Agapiou at Col. 1, lines 50-55. There is no teaching or suggestion of the method step in claim 12.

As above, replacing the Agapiou tire with a tennis ball in proximity to a squashed skunk, as the Examiner apparently contends, for "use in educating young children by providing a

visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire" would also likely reduce the Agapiou utility into a laughable exercise.

7. Agapiou Does Not Teach Or Suggest The Method Step Of Constructing A Replica Of A Soccer Ball

As to claim 13, Agapiou does not teach or suggest the method step of constructing a replica of a soccer ball, and indeed, has nothing to do with soccer balls.

As indicated above, the abstract of Agapiou indicates that the patent concerns a safety awareness kit including toy figures and that the kit is apparently for use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire. See also Agapiou at Col. 1, lines 50-55. There is no teaching or suggestion of the method step in claim 12.

As above, replacing the Agapiou tire with a tennis ball in proximity to a squashed skunk, as the Examiner apparently contends, for "use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire" would also likely reduce the Agapiou utility into a laughable exercise.

8. Agapiou Does Not Teach Or Suggest The Method Step Of Constructing A Replica Of A Rugby Ball

As to claim 14, Agapiou does not teach or suggest the method step of constructing a replica of a rugby ball, and indeed, has nothing to do with rugby balls.

As indicated above, the abstract of Agapiou indicates that the patent concerns a safety awareness kit including toy figures and that the kit is apparently for use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire. See also Agapiou at Col. 1, lines 50-55. There is no teaching or suggestion of the method step in claim 14.

As above, replacing the Agapiou tire with a rugby ball in proximity to a squashed skunk, as the Examiner apparently contends, for "use in educating young children by providing a

visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire" would also likely reduce the Agapiou utility into a laughable exercise.

9. Agapiou Does Not Teach Or Suggest The Method Step Of Constructing A Card Symbolizing Charge And Bank Cards

As to claim 15, Agapiou does not teach or suggest the method step of constructing a card symbolizing charge and bank cards, and indeed, has nothing to do with charge cards and bank cards.

As indicated above, the abstract of Agapiou indicates that the patent concerns a safety awareness kit including toy figures and that the kit is apparently for use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire. See also Agapiou at Col. 1, lines 50-55. There is no teaching or suggestion of the method step in claim 15.

As above, replacing the Agapiou tire with a card symbolizing charge and bank cards in proximity to a squashed skunk, as the Examiner apparently contends, for "use in educating young children by providing a visual impression of the hazards of pedestrian carelessness when the toy is placed in proximity to or under part of the tire" would also likely reduce the Agapiou utility into a laughable exercise.

10. Agapiou Does Not Teach Or Suggest The Method Step Of Locating A Logo On The Replica

As to claim 17, Agapiou does not teach or suggest the method step of locating a logo on the replica, and indeed, has nothing to do with logos. Agapiou teaches, at Col. 2, lines 20-26:

The side wall 28 opposed to the side wall 23 may if desired be provided with printed indicia 30. For example, a printed slogan such as "Cross On Green Not In Between" or "Don't Tread On me" may be painted on the sidewalk. Alternatively a tag or label containing the safety slogan may be adhesively fixed to the sidewall. See also claims 8-9.

Appellant submits the Agapiou teaching of printed indicia, for example, a safety

message, in the context and purpose of Agapiou (educating young children by providing a visual impression of the hazards of pedestrian carelessness), would not lead one to modify Agapiou to replace the slogan with a logo. A printed indicia such as a safety logo has a different content, meaning, and commercial impression than a logo on thematic packaging (the context of the claimed invention). There is nothing in Agapiou to suggest such a modification, and such a modification would be contrary to the purpose of Agapiou.

11. Agapiou Does Not Teach Or Suggest The Method Step Of Adding An Outer Layer Of Packaging Also Shaped To Visually Convey Information About The Associated Activity

As to claim 18, Agapiou does not teach or suggest the method step of adding an outer layer of packaging. Moreover, Agapiou does not teach or suggest having such outer layer of packaging also shaped to visually convey information about the associated activity. Agapiou says nothing whatsoever about an outer layer of packaging for the tire and squashed skunk. Further, the Final Rejection makes no contention to the contrary and provides no reason for the rejection. Apparently, claim 18 has been rejected for no apparent reason and on no apparent evidence. In that Appellant is statutorily entitled to a patent "unless" the PTO proves otherwise, and under the standards for determining obviousness set down in case law, Appellant reserves the right to argue non-obviousness should some reason be provided by the PTO for withholding a patent on claim 18.

12. Agapiou Does Not Teach Or Suggest The Method Step Of Adding An Outer Layer Of Packaging Also Shaped To Visually Convey Information About The Associated Activity, Wherein The Outer Layer Includes A Sleeve For Golf Balls

As to claim 19, Agapiou does not teach or suggest the method step of adding an outer layer of packaging. Moreover, Agapiou does not teach or suggest having such outer layer of packaging also shaped to visually convey information about the associated activity. Still further, Agapiou does not teach or suggest that the outer layer includes a sleeve for golf balls. Agapiou

says nothing whatsoever about an outer layer of a sleeve for golf balls used as packaging for the tire and squashed skunk. Further, the Final Rejection makes no contention to the contrary and provides no reason for the rejection. Apparently, claim 19 has been rejected for no apparent reason and on no apparent evidence. In that Appellant is statutorily entitled to a patent "unless" the PTO proves otherwise, and under the standards for determining obviousness set down in case law, Appellant reserves the right to argue non-obviousness should some reason be provided by the PTO for withholding a patent on claim 19.

13. Agapiou Does Not Teach Or Suggest The Method Step Of Constructing The Replica To Have Additional Utility (Beyond That Set Out In Claim 5)

As to claim 20, Agapiou does not teach or suggest the method step of constructing the replica to have additional utility (beyond that set out in claim 5). Further, the Final Rejection makes no contention to the contrary and provides no reason for the rejection. Apparently, claim 20 has been rejected for no apparent reason and on no apparent evidence. In that Appellant is statutorily entitled to a patent "unless" the PTO proves otherwise, and under the standards for determining obviousness set down in case law, Appellant reserves the right to argue non-obviousness should some reason be provided by the PTO for withholding a patent on claim 20.

14. Agapiou Does Not Teach Or Suggest The Method Step Of Constructing The Replica To Have Additional Utility of a Toy

As to claim 21, Agapiou does not teach or suggest the method step of constructing the replica to have the additional utility of a toy. Agapiou teaches toy 12 inside the container. See Col. 2, lines 50-51. Agapiou shows no contemplation of the container (tire) being used as a toy. To the contrary, Agapiou teaches educating young children by providing a visual impression of the hazards of pedestrian carelessness--not really a matter of play. Further, the Final Rejection makes no contention to the contrary and provides no reason for the rejection.

Apparently, claim 20 has been rejected for no apparent reason and on no apparent evidence. In that Appellant is statutorily entitled to a patent "unless" the PTO proves otherwise, and under the standards for determining obviousness set down in case law, Appellant reserves the right to argue non-obviousness should some reason be provided by the PTO for withholding a patent on claim 21.

15. Agapiou Does Not Teach Or Suggest The Method Step Of Constructing The Replica To Receive Subsequent Writing From A Pen Or Magic Marker Thereon

As to claim 22, Agapiou does not teach or suggest the method step of constructing the replica to receive subsequent writing from a pen or magic marker thereon. Although Agapiou teaches printed indicia 30 at Col. 2, line 21, as a slogan, the printed indicia "may be painted on" Col. 2, line 19, or put on a label or tag that is adhesively fixed" Col. 2, line 26. Agapiou also teaches that the tire tread is either formed integrally from moldable plastic or is painted on the periphery, preferably including a white stripe to give the appearance of a white-wall tire, Col. 2, lines 20-39.

Appellant submits that if the periphery is occupied by an integral or painted tread, and the side is occupied by the slogan painted thereon or the adhesive tag or label there affixed, with an area therebetween occupied by a white stripe to give the appearance of a white-wall tire, then the tire is not constructed to receive subsequent writing from a pen or magic marker thereon. Indeed such marking would interfere with the purpose taught by Agapiou, as discussed above. Further, the Final Rejection makes no contention to the contrary and provides no reason for the rejection, apparently confusing the adhesively affixed label or paint with instant claim requirement. Agapiou does not teach or suggest constructing the replica to receive subsequent writing from a pen or magic marker thereon, as is required in claim 22.

16. Agapiou Does Not Teach Or Suggest The Method Step Of Constructing The Replica To Further Include A Means For

Attaching The Replica To Another Article

As to claim 23, Agapiou does not teach or suggest the method step of constructing the replica to include means for attaching the replica to another article. Further, the Final Rejection makes no contention to the contrary and provides no reason for the rejection. Speculating for a moment to account for the rejection, Agapiou teaches "a separate base or support structure" at Col. 2, line 43. However, provision of a separate base is not the constructing of the replica to include "means for attaching" as disclosed and claimed in the instant application. Apparently, claim 23 has been rejected for no apparent reason and on no apparent evidence. In that Appellant is statutorily entitled to a patent "unless" the PTO proves otherwise, and under the standards for determining obviousness set down in case law, Appellant reserves the right to argue non-obviousness should some reason be provided by the PTO for withholding a patent on claim 23.

17. Agapiou Does Not Teach Or Suggest The Method Steps Of (A) Creating A Package Shaped Like A Particular Ball (B) To Visually Convey Information About A Particular Activity Associated With Said Ball Or (C) Containing A Member Of The Group Of Rain Gear Consisting Of A Wiping Cloth, A Rain Coat, A Rain Vest, A Golf Bag Cover, A Ditty Bag, A Poncho, A Hat, And A Seat Cover

As to claim 24, Agapiou does not teach or suggest the method steps including (A) creating a package shaped like a particular ball, as conceded by the Examiner in the Final Rejection. The Examiner points to no motive to modify the alleged teachings of Agapiou upon which the Final Rejection is premised, and the Examiner's proposed modifying of the Agapiou tire into a ball is contrary to, and would destroy the purpose of, educating young children by providing a visual impression of the hazards of pedestrian carelessness. Such a modification would render Agapiou's safety awareness kit laughable, and this is an impermissible leap from the evidence upon which the Examiner relies.

Additionally, Agapiou does not teach or suggest the claimed (B) to visually convey

information about a particular activity associated with said ball. There is no contention that Agapiou teaches or suggests anything to do with an activity associated with a ball. The Examiner points to no evidence of motive for modifying the teaching upon which the Final Rejection is premised, and the Examiner's proposed modifying of the Agapiou to convey information about an activity associated with a ball is contrary to, and would destroy the purpose of, educating young children by providing a visual impression of the hazards of pedestrian carelessness. Such a modification would render Agapiou's safety awareness kit laughable, and this is an impermissible leap from the evidence upon which the Examiner relies.

Still further, Agapiou does not teach or suggest (C) locating the claimed member of the group of rain gear consisting of a wiping cloth, a rain coat, a rain vest, a golf bag cover, a ditty bag, a poncho, a hat, and a seat cover. In speculating as to the nature of the rejection, presumably the squashed skunk toy is being viewed as modifiable into rain gear. Such a fashion statement is preposterous in the context of Agapiou. Using a wiping cloth, a rain coat, a rain vest, a golf bag cover, a ditty bag, a poncho, a hat, or a seat cover instead of the squashed skunk toy is contrary to, and would destroy the purpose of, educating young children by providing a visual impression of the hazards of pedestrian carelessness. Such a modification would render Agapiou's safety awareness kit laughable, and this is an impermissible leap from the evidence upon which the Examiner relies.

Numerous elements--especially the combination of elements A, B, and C--required in claim 24 are not shown in, and are fundamentally contrary to Agapiou, and therefore claim 24 is not obvious over the evidence.

18. **Agapiou Does Not Teach Or Suggest The Method Steps Of (A) Making Thematic Packaging As A Replica Of A Golf Ball (B) To Visually Convey Information About The Activity Of A Game Of Golf, Or (C) Locating Rain Gear... Within... Such That The Rain Gear Is**

Visually Associated For Use In The Activity Of Playing The Game Of Golf In The Rain

As to claim 25, Agapiou does not teach or suggest the method steps including (A) making thematic packaging as a replica of a golf ball, and indeed has nothing to do with golf or golf balls, as conceded by the Examiner in the Final Rejection. The Examiner points to no motive to modify the teaching upon which the Final Rejection is premised, and the Examiner's proposed modifying of the Agapiou tire into a golf ball is contrary to, and would destroy the purpose of, educating young children by providing a visual impression of the hazards of pedestrian carelessness. Such a modification would render Agapiou's safety awareness kit laughable, and this is an impermissible leap from the evidence upon which the Examiner relies.

Additionally, Agapiou does not teach or suggest the claimed (B) to visually convey information about the activity of a game of golf. Again, there is no contention that Agapiou teaches or suggests anything to do with conveying information about the game of golf. The Examiner points to no motive to modify the teaching upon which the Final Rejection is premised, and the Examiner's proposed modifying of Agapiou to convey information about the game of golf is contrary to, and would destroy the purpose of, educating young children by providing a visual impression of the hazards of pedestrian carelessness. Such a modification would render Agapiou's safety awareness kit laughable, and this is an impermissible leap from the evidence upon which the Examiner relies.

Still further, Agapiou does not teach or suggest (C) locating rain gear... within... such that the rain gear is visually associated for use in the activity of playing the game of golf in the rain. The Examiner points to no motive to modify the teaching upon which the Final Rejection is premised, and the Examiner's proposed modifying of Agapiou to locate rain gear... within... such that the rain gear is visually associated for use in the activity of playing the game of golf in the rain is contrary to, and would destroy the purpose of, educating young children by providing a

visual impression of the hazards of pedestrian carelessness. Such a modification would render Agapiou's safety awareness kit laughable, and this is an impermissible leap from the evidence upon which the Examiner relies.

Numerous elements--especially the combination of elements A, B, and C--required in claim 25 are not shown in, and are fundamentally contrary to Agapiou, and therefore claim 25 is not obvious over the evidence.

19. Agapiou Does Not Teach Or Suggest The Method Steps Of (A) Making Thematic Packaging As A Replica Of A Baseball (B) To Visually Convey Information About The Activity Of A Game Of Baseball Or (C) Locating Rain Gear... Within... Such That The Rain Gear Is Visually Associated For Use In The Activity Of Watching The Game Of Baseball In The Rain

As to claim 25, Agapiou does not teach or suggest the method steps including (A) making thematic packaging as a replica of a baseball, and indeed has nothing to do with the game of baseball or baseballs, as conceded by the Examiner in the Final Rejection. The Examiner points to no motive to modify the teaching upon which the Final Rejection is premised, and the Examiner's proposed modifying of the Agapiou tire into a baseball is contrary to, and would destroy the purpose of, educating young children by providing a visual impression of the hazards of pedestrian carelessness. Such a modification would render Agapiou's safety awareness kit laughable, and this is an impermissible leap from the evidence upon which the Examiner relies.

Additionally, Agapiou does not teach or suggest the claimed (B) to visually convey information about the activity of a game of baseball. Again, there is no contention that Agapiou teaches or suggests anything to do with conveying information about the game of baseball. The Examiner points to no motive to modify the teaching upon which the Final Rejection is premised, and the Examiner's proposed modifying of the Agapiou to convey information about the game of golf is contrary to, and would destroy the purpose of, educating young children by providing a

visual impression of the hazards of pedestrian carelessness. Such a modification would render Agapiou's safety awareness kit laughable, and this is an impermissible leap from the evidence upon which the Examiner relies.

Still further, Agapiou does not teach or suggest (C) locating rain gear... within... such that the rain gear is visually associated for use in the activity of watching the game of baseball in the rain. The Examiner points to no motive to modify the teaching upon which the Final Rejection is premised, and the Examiner's proposed modifying of Agapiou to locate rain gear... within... such that the rain gear is visually associated for use in the activity of watching the game of baseball in the rain is contrary to, and would destroy the purpose of, educating young children by providing a visual impression of the hazards of pedestrian carelessness. Such a modification would render Agapiou's safety awareness kit laughable, and this is an impermissible leap from the evidence upon which the Examiner relies.

Numerous elements--especially the combination of elements A, B, and C--required in claim 26 are not shown in, and are fundamentally contrary to Agapiou, and therefore claim 26 is not obvious over the evidence.

20. Agapiou Does Not Teach Or Suggest The Method Step Of Packaging The Package Within An Other Package Suggestive Of The Member Of The Group

As to claim 27, Agapiou does not teach or suggest the method step of adding an outer layer of packaging. Moreover, Agapiou does not teach or suggest having such outer layer of suggestive packaging. Further, the Final Rejection makes no contention to the contrary and provides no reason for the rejection. Apparently, claim 27 has been rejected for no apparent reason and on no apparent evidence. In that Appellant is statutorily entitled to a patent "unless" the PTO proves otherwise, and under the standards for determining obviousness set down in case law, Appellant reserves the right to argue non-obviousness should some reason be provided by the PTO for withholding a patent on claim 27.

21. Agapiou Does Not Teach Or Suggest The Method Step Of (A) Engaging Lips On Respective Portions Of The Package To Encase The Article, Or (B) The Portions Forming Halves Of The Hollow When Joined

As to claim 28, Agapiou does not teach or suggest the method step including (A) engaging lips on respective portions of the package to encase the article. Additionally, Agapiou does not teach or suggest that the portions of the package form halves of the hollow when joined. Agapiou teaches that the opening is provided in one sidewall (See Fig. 2 and Col. 2, lines 13-19), not so as to form halves. With regard to the engaging lips, Agapiou teaches that one of the embodiments can be of cardboard, Col. 2, line 31, and it is not seen from the evidence of record how engaging lips would be constructed from cardboard. The Examiner points to no other motive to modify Agapiou, and the Examiner's proposed modifying of the Agapiou tire to reach the instant claim requirements is contrary to Agapiou's teaching, and this is an impermissible leap from the evidence upon which the Examiner relies. In sum, the Examiner has not provided the evidence required to show obviousness of the claim requirements.

22. Agapiou Does Not Teach Or Suggest The Method Step Of Engaging Lips On Respective Portions Of The Ball

As to claim 31, it has previously been pointed out, in various sections, that Agapiou does not teach anything about locating an article in a ball, and that the consequence of modifying Agapiou's tire into a ball would render his purpose of providing a visual impression of the hazards of pedestrian carelessness into a joke. The same argument is incorporated here.

Further, as indicated above, with regard to the engaging lips, Agapiou teaches that one of the embodiments can be of cardboard, Col. 2, line 31, and it is not seen from the evidence of record how engaging lips would be constructed from cardboard. The Examiner points to no other motive to modify Agapiou, and the Examiner's proposed modifying of the Agapiou tire to reach the instant claim requirements is contrary to Agapiou's teaching, and this is an impermissible leap from the evidence upon which the Examiner relies. In sum, the Examiner has

not provided the evidence required to show obviousness of the claim requirements.

XI. CONCLUSION

The rejection of each group of Appellant's claims pursuant to Sec. 102 and Sec. 103 is in error because Appellant's claimed method features, as a whole, are not disclosed or suggested in the cited reference, except by illogical hindsight reading into an apparatus teaching inspired by Appellant's method steps.

Thus, for the reasons more fully set out above, all pending claims and the aforesaid groups of claims are patentable, and the rejection of them was in error with allowance being respectfully requested.

Respectfully submitted,



Peter K. Trzyna
(Reg. No. 32,601)

Date: December 19, 2000

P.O. Box 7131
Chicago, IL 60680-7131

(312) 240-0824

Appendix

5. A method for making a combination of a thematic package and an article contained within the package, the method including the steps of:

constructing the package as a replica of a recognizable icon, the package having a shape that is different than a shape of the article contained therein,

the shape of the package visually conveying information about an activity associated with the icon in which the article is used, and,

the package having a hollow interior; and

locating the article within the hollow interior of the package to form a combination of the article and the thematically-shaped package.

8. The method of claim 5, wherein the step of constructing includes:
constructing a replica of a golf ball.

9. The method of claim 5, wherein the step of constructing includes:
constructing a replica of a baseball.

10. The method of claim 5, wherein the step of constructing includes:
constructing a replica of a life preserver.

11. The method of claim 5, wherein the step of constructing includes:
constructing a replica of a football.

12. The method of claim 5, wherein the step of constructing includes:
constructing a replica of a tennis ball.

13. The method of claim 5, wherein the step of constructing includes:
constructing a replica of a soccer ball.

14. The method of claim 5, wherein the step of constructing includes:
constructing a replica of a rugby ball.

15. The method of claim 5, wherein the step of constructing includes:
constructing a card symbolizing charge and bank cards.

17. The method of claim 5, further including the step of locating a logo on the
replica.

18. The method of claim 5, further including the step of: adding an outer layer
of packaging also shaped to visually convey information about the associated activity.

19. The method of claim 18, wherein the outer layer includes a sleeve for golf
balls.

20. The method of claim 5, wherein the step of constructing further includes the
step of:

constructing the replica to have additional utility and having a shape visually
conveying information about an activity associated with the replica.

21. The method of claim 19, wherein the step of constructing the replica to

have additional utility includes the step of:

constructing a toy.

22. The method of claim 20, wherein the step of constructing the replica to have additional utility further includes the step of:

constructing the replica to receive subsequent writing from a pen or magic marker thereon.

23. The method of claim 5, further including a means for attaching the replica to an other article.

24. A method for making packaging, the method including the steps of:
providing an object in a package,
the package being shaped like a particular ball to visually convey information about a particular activity associated with said ball,
the object being a member of the group of rain gear consisting of a wiping cloth, a rain coat, a rain vest, a golf bag cover, a ditty bag, a poncho, a hat, and a seat cover
the member being useful during the activity wherein the package is openable to remove the object for use of the object while engaged in the associated activity.

25. A method for making thematically-shaped packaging for a thematically associated article contained therein, the method including the step of:
constructing a package having a shape that is a recognizable icon visually conveying information about an activity associated with the icon,
the package having a hollow interior to form the packaging for the article;

locating the article within the hollow interior of the package,

the article having a use in the associated activity to form a combination of the article and the thematically-shaped packaging; and wherein the step of constructing further includes the step of:

constructing the package as a replica of a golf ball to visually convey information of association of the activity of a game of golf; and wherein the step of locating the article within the packaging further includes the step of:

locating rain gear, as the article, within the hollow interior of the replica such that the rain gear is visually associated for use in the activity of playing the game of golf in the rain.

26. A method of making thematically-shaped packaging for an article contained therein, the method including the steps of:

constructing the package as a replica of a symbol having a shape that visually conveys information about an activity associated with the symbol,

the package having a hollow interior to form the packaging for the article;

locating the article within the hollow interior of the packaging,

the article having a use in the associated activity

and forming activity and forming a combination of the article and the thematically-shaped packaging;

and wherein the step of constructing further includes the step of:

constructing the package as a replica of a baseball to visually convey information about the associated activity of a baseball game;

and wherein the step of locating the article within the package further

includes the step of:

locating rain gear, as the article, within the packaging such that the rain gear is visually associated with the associated activity of watching the baseball game in the rain.

27. The method of any one claims 5 and 8-23, further including the step of:
packaging the package within an other package, the other package suggestive of the member of the group.

28. The method of any one of claims 5 and 8-23, wherein the step of locating the article within the hollow includes engaging lips on respective portions of the package to encase the article, the portions forming halves of the hollow when joined during the locating step.

29. The method of any one claims 5 and 8-23, wherein the step of constructing includes constructing out of plastic.

30. The method of claim 29, wherein the step of locating is carried out with the article being an article made of plastic.

31. The method of claim 26, wherein the step of locating the article within the hollow includes engaging lips on respective portions of the ball to encase the article.